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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,271	07/13/2005	Jun-mo Gil	26706U	5071
20529	7590	01/28/2008		
NATH & ASSOCIATES 112 South West Street Alexandria, VA 22314			EXAMINER BAUSCH, SARAE L	
			ART UNIT 1634	PAPER NUMBER
			MAIL DATE 01/28/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/531,271

Applicant(s)

GIL ET AL.

Examiner

Sarae Bausch

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 8-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 07/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to applicants correspondence mailed 11/02/2007.

Election/Restrictions

2. Applicant's election of group I, claims 1-7 in the reply filed on 11/02/2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
3. Claims 8-13 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 11/02/2007.

Sequence Rules

4. This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825. There are no sequence identifiers for the sequences on pages 21-23 of the specification. Additionally, there is no sequence listing or CRF of the sequences in the specification. Applicant is required to thoroughly review the specification and comply with all sequence rules. For any response to this office action to fully responsive, applicants are required to comply with sequence rules.

Specification

5. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 is vague and indefinite for the recitation of "characterized in that said marker is added to materials selected from the group consisting of... paint". Claim 2 appears to be drawn to a product comprised of a process and there it is unclear if claim 2 is drawn to a process or product. The recitation of characterized in that and the recitation of marker is added to materials appears to be a process step. As such it is unclear if the claim is intended to be limited to a product or process.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Dollinger et al. (US Patent 5451505).

With regard to claim 1, Dollinger et al. teach a taggant which comprises a nucleic acid that has a specific nucleotide sequence that provides a means to store information (marker composed of oligonucleotides). Dollinger et al. teach taggants are added to substances.

Dollinger et al. teach substances to include automobiles and automobile parts (see column 1, lines 20-27 and column 3, lines 65-68) (vehicle identifying markers). Dollinger et al. teaches the taggants may be covalently bound to a solid support such as latex beads, dextran or magnetic beads or encapsulated by polymeric substances or lipophilic compositions (see column 2, lines 24-29) (oligonucleotides to which phase transfer agent is bound).

With regard to claim 2, Dollinger et al. teach the substances that contain the taggants (nucleic acids bound to a phase transfer agent) are paint products. It is noted that any paint product could be applied to a vehicle or could be used to coat a vehicle. Therefore the paint product taught by Dollinger et al. includes vehicle paint product and vehicle coating solution.

With regard to claim 3-4, Dollinger et al. teach a taggant sequence that comprises an oligonucleotide composed of a unique sequence of one strand and primer sequences located at both ends of the unique sequence (see table 1, taggant sequence and column 6, lines 64-68).

Dollinger et al. teach the nucleic acid taggant will be at least 20 bases in length to adequately specify any taggant (coding sequence is 10 to 50 base pairs) (see column 5, lines 5-11).

With regard to claims 5-6, Dollinger et al. teach a taggant that is a combination of two primers and a unique sequence (see table 1, taggant sequence, column 6 lines 64-68) (three kinds of oligonucleotides with different base sequences).

With regard to claim 7, Dollinger et al. teach derivatized nucleotides, including methyl or phosphonate oligodeoxynucleotides and phosphorothioate oligodeoxynucleotides (oligonucleotide combined with protective groups (derivatized nucleotides) which blocks reactivity).

10. Claims 1 and 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Le Page et al. (WO 87/06383, cited on IDS).

With regard to claim 1, Le Page et al. teach an article labeled with a tag to which a signal compound is attached (see page 5, 2nd full para.) Le Page et al. teach the signal compound may be attached to an adhesive or paper (oligonucleotide to which phase transfer agents is bound) (see page 5, 1st and 2nd full para). LePage et al. teach the tag and signal compounds are nucleic acids (see pg. 5 last para. con't to page 6). Le Page et al. teach the substance comprising the tag and signal can be any substance including parts for cars (see pg. 4 last para con't to page 5) (vehicle identification marker).

With regard to claim 5-6, Le Page et al. teach an item is labeled with a signal DNA in which there are two or more signal DNAs that is genuine. Le Page et al. teach the signal DNA is mixed with another DNA (see pg. 9, last para. con't to 1st para) (vehicle identifying marker that is a combination of different base sequences of two or more, combination of three).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title; if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dollinger (US Patent 5451505).

Dollinger et al. teach a taggant which comprises a nucleic acid that has a specific nucleotide sequence that provides a means to store information (marker composed of oligonucleotides). Dollinger et al. teach taggants are added to substances. Dollinger et al. teaches substances to include automobiles and automobile parts (see column 1, lines 20-27 and column 3, lines 65-68) (vehicle identifying markers). Dollinger et al. teaches the taggants may be covalently bound to a solid support such as latex beads, dextran or magnetic beads or encapsulated by polymeric substances or lipophilic compositions (see column 2, lines 24-29) (oligonucleotides to which phase transfer agent is bound). Dollinger et al. does teach a composition of tagged substances wherein the taggant is a nucleic acid and the substance is paint products. Dollinger et al. does not teach a composition of vehicle painting dye or vehicle coating solution.

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Therefore, it would be have been prima facie obvious to the ordinary artisan at the time the invention was made to include vehicle painting dye and vehicle coating dye in the composition as Dollinger teaches taggants can be added to either automobiles, automobile parts, and paint products. The ordinary artisan would have been motivated to include vehicle painting dye and vehicle coating dye as Dollinger teaches that both automobile part and paint products can contain taggants. Additionally, the ordinary artisan would have had a reasonable expectation of success since the compositions taught by Dollinger include both automobiles and paint products, which are encompassed by vehicle painting dye and vehicle coating dyes.

14. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Le Page (WO87/06383, cited on IDS).

Le Page et al. teach an article labeled with a tag to which a signal compound is attached (see page 5, 2nd full para.) Le Page et al. teach the signal compound may be attached to an adhesive on paper (oligonucleotide to which phase transfer agents is bound) (see page 5, 1st and 2nd full para). LePage et al. teach the tag and signal compounds are nucleic acids (see pg. 5 last para. con't to page 6). Le Page et al. teach the substance comprising the tag and signal can be any substance including parts for cars or art work. (see pg. 4 last para con't to page 5) (vehicle identification marker).

Le Page et al. does not teach a composition of vehicle painting dye or vehicle coating solution.

Therefore, it would be have been prima facie obvious to the ordinary artisan at the time the invention was made to include vehicle painting dye and vehicle coating dye in the

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composition taught by Le Page as Le Page teaches signal compounds can be added to any substance, including art work and car parts. The ordinary artisan would have been motivated to include vehicle painting dye and vehicle coating dye as Le Page teaches signal compounds can be added to any substance, including art work and car parts. Additionally, the ordinary artisan would have had a reasonable expectation of success since the compositions taught by Le Page include both car parts and art work, which are encompassed by vehicle painting dye and vehicle coating dyes.

Conclusion

15. No claims are allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sarae Bausch whose telephone number is (571) 272-2912. The examiner can normally be reached on M-F 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla can be reached on (571) 272-0735. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

/Sarae Bausch/
Sarae Bausch, PhD.
Examiner
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